

REMARKS

This is a complete response to the outstanding final Office Action mailed April 12, 2006. Claims 1-24, 27, 29, 31-33, 35, 37-38, and 43 have been canceled herein. Claims 24, 30, 34, 39, and 40 have been amended herein. No new matter has been added. Support for amendments to claims 24, 30, 34, 39, and 40 may be found in, for example, canceled claims 1-24, 27, 29, 31-33, 35, 37-38, and 43. Upon entry of the enclosed claim amendments, claims 24-26, 28, 30, 34, 36, 39, and 40-42 remain pending in the present application.

The Applicant traverses all of the objections and rejections of the Office Action. Applicant appreciates the Examiner's review of the above-identified patent application and respectfully requests reconsideration and allowance in view of the above amendments and following remarks.

I. Response to Claim and Specification Objections

The current title adequately describes Applicant's invention.

The Examiner's suggestion of adding limitations would limit the scope of Applicant's invention beyond Applicant's intentions.

Applicant appreciate the Examiner suggest but wish not to amend

the tile of the invention.

Applicant has amended paragraph [0007] from "magically" to "automatically" as suggested by the Examiner.

With regard to the first, the second, the third devices. The current wording points out and distinctly claims the subject matter of the invention. Applicant's reference to first, second, and third is relative to the system, device, or method of the claim. The "of" portion of the phrase merely relates to whom the device is associated.

II. Response to Claim Rejections Based on Anticipation

The claim rejections based on anticipation by the reference U.S. patent 6,771,766 to Shafiee et al. (herein after Shafiee) are moot in view of Applicant's claim amendments herein.

To establish a prima face case of anticipation, the Examiner bears the burden to first show a correct interpretation, including the scope and meaning, of each contested limitation. *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997). This is required, in part, so that the Applicant can ascertain whether or not the Examiner understands the

invention, and so that the Applicant can frame a response. 37
CFR 1.106(b).

Shafiee does not disclose providing a list of allowed communication sessions or causing a log-in of the second device using the provided code. Therefore amended claims 34, 30, 24, 39, and 40 should not be rejected as anticipated by Shafiee.

The office actions generally uses (or, rather, misuses) selected *portions* of (not the *entire literal*) claim language rather a generic interpretation to fabricate rejections and vague reference to the skills database referenced by figure 7, figure 8, and col. 11, lines 5-31 of Shafiee in no way satisfy the Examiner's burden. Therefore, the anticipation rejection by Shafiee does not apply to amended claims 24-26, 28, 30, 34, 36, 39, and 40-42.

III. Response to Claim Rejections Based on Obviousness

The claim rejections based on obviousness by the reference U.S. patent 6,771,766 to Shafiee et al. (herein after Shafiee) in view of obviousness are moot in view of Applicant's claim amendments herein.

Applicant urges that the Examination lacks the evidence, facts, or findings sufficient to establish a *prima face* case of obviousness. To establish a *prima face* basis for obviousness, the Examiner bears the burden to show the factual basis of the rejection. *In re Warner*, 379 F.2d 1011, 389 U.S. 1057 (1968). Such basis must be both factually sufficient, and reasonable.

In addition, to establish a *prima face* case of obviousness, the Examiner further bears the burden to first show a correct interpretation, including the scope and meaning, of each contested limitation. *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997). This is required, in part, so that the Applicant can ascertain whether or not the Examiner understands the invention, and so that the Applicant can frame a response. 37 CFR 1.106(b).

However, in the present examination, each of the rejections is so vague and ambiguous that the genuine basis for each rejection can scarcely be gleaned, and thus the Examination fails to make a *prima face* case for rejection. Thus, assuming *ad arguendo* that the reference was properly combined with obviousness as suggested by the Examiner, the combination does not yield the Applicant's invention.

Nowhere in the Office Action does the Examiner identify the relevant claim elements for either the Applicant's invention or for the cited reference (*Shafiee*). Rather, the Examiner generally uses (or, rather, misuses) selected portions of (not the *entire literal*) claim language to fabricate rejections, where clearly the use of the Applicant's actual claim language would definitively negate the alleged grounds for rejection. In fact, the Examiner appears to merely attempt to make a case for the obviousness based on a generic interpretation of the claims as a whole, while completely ignoring both the elements of the claims--both independent and dependent.

The following terms constitute some of the relevant claim elements. Here it is emphasized that the underlined claim elements are *not even identified* by the Examiner, much less defined in scope or limitation:

causing a determination as to whether said request is authorized;

causing a list of allowed communication sessions to be determined;

causing said list of allowed communication sessions and an authorization code to be provided to said first device,

receiving a selection of an allowed communication session
for said second communication session, and

causing a destination address and an identification code
for said second communications session to be sent to said second
device; and

causing a log-in of said second device at said destination
address using said identification code.

Often, the Examination seems to attempt to make connections and draw conclusions based on what the Examiner deems to be common sense or obviousness. Exemplified in sections 21 and 20 of the Office Action. Recently, Judge Newman, in her opinion in *In re Lee*, 277 F3d. 1338, 1343, 61 USPQ2d 1430 (Fed Cir. 2002), repeated a fundamental principle that an Examination cannot simply rely upon "common knowledge" or "common sense" (even when couched in term of "Official Notice"):

The "common knowledge and common sense" on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated ...The Board's findings must extend to all material facts and must be **documented on the record**, lest the "haze of so-called expertise" acquire insulation from accountability. **"Common knowledge and common sense"**,

even if assumed to derive from the agency's expertise,
do not substitute for authority when the law requires
authority. *Id.*

Official Notice is not a citation, and is not a tool of rejection. Rather, Official Notice is a doctrine an Examiner can invoke, *at the request of the Applicant*, to avoid the need to prove-up various matters to which both the Examiner and the Applicant agree are well known. This is not the case here. Thus, the Examination is misusing the doctrine of Official Notice, and any rejections or motivations for combinations based thereon should be withdrawn and must be provided.

Therefore, the prior obviousness rejection by Shafiee in view of obviousness does not apply to amended claims 24-26, 28, 30, 34, 36, 39, and 40-42.

IV. Prior Art Made of Record

The prior art made of record has been considered, but is not believed to affect the patentability of the presently pending claims.

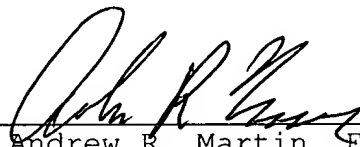
In re: Sam Wen
Filed: October 16, 2001
Serial No.: 09/981,317
Page 20

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and rejections have been traversed, rendered moot and/or accommodated, and that presently pending claims 24-26, 28, 30, 34, 36, 39-42 are in condition for allowance. Favorable reconsideration and allowance of the present application and the presently pending claims are hereby courteously requested. The examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

Respectfully submitted,

Sam Wen et al.

By 
Andrew R. Martin, Esq.
Registration No. 45,413
Attorney for Applicant

BOURQUE & ASSOCIATES, P.A.
835 Hanover Street, Suite 301
Manchester, New Hampshire 03104

Telephone: (603) 623-5111
Facsimile: (603) 624-1432

Date: 7/12/04

In re: Sam Wen
Filed: October 16, 2001
Serial No.: 09/981,317
Page 21